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Re: **Application Serial No.:** 09/193,565
Confirmation No.: 2182
Appellants: Jay Paul Drummond, et al.
Title: Automated Banking Machine and System
Docket No.: D-1077+2

Sir:

Please find enclosed the Supplemental Appeal Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate, in response to the Action dated June 12, 2003, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Supplemental Appeal Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,


Ralph E. Jocke

CERTIFICATE OF MAILING BY EXPRESS MAIL

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D-1077+2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
Jay Paul Drummond, et al.)	
)	
Serial No.: 09/193,565)	Art Unit 3621
)	
Confirmation No.: 2182)	
)	
Filed: November 17, 1998)	Patent Examiner
)	Pierre Eddy Elisca
)	
For: Automated Banking)	
Machine and System)	

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**SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.192**

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Sir:

The Appellants hereby respectfully request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit the Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-20 are pending in the Application.

Claims 1-6, 10-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. (US 5,706,442) ("Anderson").

Claims 7-9 and 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official notice.

These rejections were the only rejections present in the Office Action ("Action") dated June 12, 2003. Appellants appeal each claim rejection, inclusive.

STATUS OF AMENDMENTS

The following dates and papers are associated with this application:

1. 09/19/01 Office Action (Final Rejection)
2. 12/17/01 Notice of Appeal
3. 02/13/02 Appeal Brief
4. 05/07/02 Examiner's Answer
5. 06/07/02 Petition -- impermissible new rejection in the Examiner's Answer
6. 06/10/02 Reply Brief

7. 02/25/03 Office Action with Final Rejection
8. 04/01/03 Petition -- premature final rejection in the 02/25/03 Office Action
9. 06/12/03 Non-final Office Action with prosecution reopened

Appellants desire to proceed with their appeal to prevent further unnecessary prosecution delay by the Office. Each of the petitions is considered by the Appellants as having been fully answered by the Office. Thus, no petitions are outstanding. Furthermore, as shown in more detail herein, Appellants' claims are allowable over the new grounds of rejection applied in the Action. Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

No final rejection is pending. However, claims have been rejected numerous times. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary form of the invention includes an automated transaction machine, such as an ATM. The ATM is associated with a computer. To accommodate the situation where a user desires to conduct a transaction that is not available with the ATM, software executable in the computer can provide an appropriate display message to the user to indicate that the transaction is not available. The software can include a browser which enables the ATM to access HTML documents through a network. These documents can include a display reference corresponding to the availability of the transaction function devices in the ATM.

The exemplary ATM can include a function which checks for the availability of each type of transaction function device within the machine. Information indicative of the available transaction devices can be generated by the ATM. This information can be directed from the ATM to a server. The server can provide to the ATM appropriate HTML documents which correspond to the types of transactions that the ATM is capable of performing. As a result the ATM can avoid the presentation to users of screen displays produced responsive to HTML documents which include references to transaction types that the machine is not capable of performing. For example, an ATM may normally accept deposits, but its depository is full. In that situation the ATM can change the documents it accesses, to present display messages to users reflecting that the deposit option is no longer offered.

Documents selectively delivered through a network to an ATM in exemplary embodiments may be static documents or may be generated at run time from sub-documents, to provide appropriate outputs and/or instructions through a screen and/or other output devices of the ATM. Thus, the ATM may adjust its operation and customer interface to respond to changing conditions.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1-6, 10-14, and 17-20 are unpatentable under 35 U.S.C. § 103(a) over Anderson.
- 2). Whether Appellants' claims 7-9 and 15-16 are unpatentable under 35 U.S.C. § 103(a) over Anderson in view of Official notice.

GROUPING OF CLAIMS

No group of claims stand or fall together. Each of Appellants' claims recite at least one element, combination of elements, or step not found or suggested in Anderson or the Official notice, which patentably distinguishes the claims.

Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

The rejected claims include four independent claims (claims 1, 7, 10, and 19). Claims 2-6 and 13-14 depend from claim 1. Claims 8-9 and 15-16 depend from claim 7. Claims 11-12 and 17-18 depend from claim 10. Claim 20 depends from claim 19. All pending claims 1-20 are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of

obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Anderson

Anderson is directed to a system for delivering financial information. Anderson's "Conductor" system is a sophisticated computer software system based on distributed system technology (col. 1, lines 56-57). The distributed system includes a Conductor system architecture network. The system works to provide timely financial information to users. The system permits users to review activity and balances relating to their accounts. For example, the system permits a user to use a PC to "access information regarding recent account activity or

their account balances" (col. 1, lines 12-14) "so that users may review activity and balances" (col. 2, line 1). Anderson's financial information service system is capable of servicing (fulfilling) financial information requests (col. 5, lines 24-47; col. 6, lines 19-23). The information requests are related to the viewing of account information, such as recent debit card transactions (col. 5, lines 24-47). The requested financial information may be transmitted back to the user (col. 5, lines 28-31; col. 1, lines 52-55). Anderson's service enables a user to check or verify their bill payments.

(iv) 35 U.S.C. § 103

Appellants traverse the rejections on the grounds that Appellants' claims recite features, relationships, and/or steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features, relationships, and/or steps recited in Appellants' claims patentably distinguish over the applied reference(s).

To establish *prima facie* obviousness, the prior art references must teach or suggest all the claim limitations. MPEP § 2142. Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper.

Appellants respectfully submit that none of the applied reference(s), taken alone or in combination, disclose or suggest the features, relationships, and/or steps that are specifically recited in the claims. Additionally, even if it were somehow possible for the reference(s) to have disclosed certain features as alleged, it still would not have been obvious to have combined the reference(s) as alleged. Furthermore, even if it were somehow possible for the reference(s) to be

combined as alleged, the resultant combination still would not have produced Appellants' claimed invention.

The Office has not established a *prima facie* showing of obviousness. Therefore, the Appellants respectfully submit the rejections are improper and should be withdrawn.

The Claims Are Not Obvious Over Anderson

Claims 1-6, 10-14, and 17-20 were rejected under 35 U.S.C. § 103(a) as obvious over Anderson. These rejections are respectfully traversed.

Claim 1

The Action admits that Anderson fails to disclose or suggest an automated transaction machine located at a first location. The Action also admits that Anderson fails to disclose or suggest at least one available transaction function device, where each respective available transaction function device is selectively operative to carry out a respective different type of transaction function.

Appellants agree that Anderson is deficient in the features for which it is relied upon by the Office in presenting the rejections. Furthermore, Anderson is the sole reference that the rejection relies upon. Appellants respectfully submit that in light of the Action's admission that Anderson fails to disclose or suggest all of the recited features and relationships, and the lack of any other evidence of record to support the rejection, the rejection is not legally valid. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

Furthermore, Appellants respectfully submit that Anderson lacks many more of the recited features and relationships than those admitted in the Action. Anderson is also devoid of any teaching, suggestion, or motivation for combining features so as to produce the claimed invention. Thus, the 35 U.S.C. § 103(a) rejections should be withdrawn.

Anderson does not teach or suggest an automated transaction machine including at least one transaction function device, a computer, and software in the manner recited. Anderson does not teach or suggest an automated transaction machine with the capability to access an HTML document which corresponds to the availability of transaction function devices in the automated transaction machine.

The Action alleges that Anderson's system is equivalent to the recited automated transaction machine. The Appellants respectfully disagree. Anderson's distributed system cannot constitute the recited machine. Furthermore, automated transaction machines have well known meaning in the art. For example, note Specification page 1.

The Action further apparently relies on Anderson's network clients/servers ("servers") as the recited "transaction function device." The Appellants respectfully disagree. Anderson does not teach a transaction function device in an automated transaction machine in the manner recited. Anderson does not teach that an available transaction function device is selectively operative to carry out a transaction function. It is unclear how alleged servers in Anderson can be viewed by the Office as a transaction function device (and a transaction function device in a machine) as recited in the claims. Thus, a server in Anderson cannot constitute a transaction function device in the manner recited. It follows that Anderson cannot teach or suggest the recited automated transaction machine.

Furthermore, there is no evidence that Anderson's system permits a transaction function in the manner recited. Anderson is concerned with permitting a user operating a PC to "access information regarding recent account activity or their account balances" (col. 1, lines 12-14) "so that users may review activity and balances" (col. 2, line 1). That is, Anderson is concerned with permitting users to view current account information. Anderson provides a financial information service system capable of responding to financial information requests (col. 5, lines 24-47; col. 6, lines 19-23). These information requests are related to the viewing of account information, such as recent debit card transactions (col. 5, lines 24-47). The requested information may be transmitted back to the user (col. 5, lines 28-31; col. 1, lines 52-55). The service enables a user to check or verify their bill payments. Thus, Anderson is not concerned with the ability to carry out a transaction function in the manner recited.

Anderson also does not teach software capable of enabling a computer to access an HTML document which corresponds to the availability of transaction function devices in an automated transaction machine. That is, Anderson does not correlate transaction function devices available in an automated transaction machine to the particular document which is accessed.

Even if it were somehow possible (which it isn't) for the distributed system in Anderson to constitute the recited automated transaction machine and for the servers in Anderson to constitute each transaction function device, then Anderson would still not teach or suggest the capability to access an HTML document corresponding to the available transaction function devices (alleged servers) in the machine. Anderson lacks any teaching or suggestion whatsoever of determining available transaction function devices (alleged servers). It follows that Anderson

lacks the capability to selectively access an HTML document based on the available transaction function devices (alleged servers) in the machine. Where does Anderson teach or suggest software capable of enabling a computer to access an HTML document which is based on the availability of servers (the alleged transaction function devices) in an automated transaction machine? Additionally, it would appear that if Anderson's servers (the alleged transaction function devices) were down (i.e., not available) then no document could be accessed.

Furthermore, Anderson is not concerned with the "type" of transaction function that can be carried out by a respective available transaction function device (alleged as servers). There is nothing in Anderson that links an HTML document to the different types of available transaction functions. That is, Anderson does not teach or suggest using an HTML document correlating to hardware status (the availability of transaction function devices). Nor does Anderson teach or suggest the recited arrangement which includes an automated transaction machine operative to access an HTML document corresponding to hardware in the machine that is available to be operated. It follows that the servers in Anderson cannot constitute a transaction function device. Nor does Anderson teach or suggest the recited software.

In an exemplary embodiment of the recited invention the apparatus has the flexibility to change the operation and customer interface of an ATM to respond to changing machine conditions (e.g., Specification page 37, line 20 to page 38, line 10; and page 18, line 5 to page 19, line 6). Conditions may change so that certain transaction functions are not available. For example, a machine may have the ability to accept deposits until its depository is full. Then the machine may change the HTML documents it accesses to display different messages to users so that the deposit option is no longer offered. As a result the machine avoids displaying documents

which include references to transactions which are not available. Hence, in the exemplary embodiment, the machine would be able to access a (different) HTML document which corresponds to the availability of the transaction function devices in the machine. Anderson does not teach or suggest these features and relationships.

The Action admits that Anderson lacks an automated transaction machine located at a first location. The Action's rationale for modifying Anderson with the admittedly absent features is incomprehensible. For example, the Action states that "This implication discloses the use of assisting the user or customer in any location." What implication? Also, how can an implication disclose? The Action's reliance on Anderson's alleged servers as a transaction function device is without basis. The evidence of record does not teach or suggest the recited features.

As previously discussed, Anderson is not related to an automated transaction machine, where available transaction function devices are selectively operative to carry out a different types of transaction functions, and where the software is operative to enable a computer to access an HTML document which corresponds to the availability of the transaction function devices in the machine.

Furthermore, even if it were somehow possible to combine features in Anderson (which it isn't) this would not render the resultant combination obvious because Anderson does not suggest the desirability of the combination (MPEP § 2143.01).

The attempts in the Action to modify Anderson are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir.

1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The Office has not established a *prima facie* showing of obviousness. Appellants have shown that Anderson does not teach or suggest the recited features and relationships. Nor does the evidence of record teach or suggest the recited features. Nor would it have been obvious to one having ordinary skill in the art to have modified Anderson to have produced Appellants' recited invention. Nor would the alleged modification of Anderson (if somehow even possible) have resulted in the recited features and relationships. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection is improper.

Claim 2

Anderson does not teach or suggest a machine including different types of transaction function devices. The Action alleges servers in Anderson as the recited transaction function devices. Even if it were somehow possible (which it isn't) for Anderson to have servers which constituted the recited transaction function devices, then Anderson would still fail to teach or suggest that the servers are of "different types."

Anderson also does not teach or suggest that a computer operates a browser to access an HTML document by generating an address, where at least a portion of the address is indicative of at least one of the types of transaction function devices in the machine. Where does Anderson teach or suggest generating an address indicative of a type of transaction function device included in an automated transaction machine? Where does Anderson teach or suggest anything indicative of any type of transaction function device included in any automated transaction machine? Where does Anderson generate an address indicative of a type of transaction function

device? The cited sections of Anderson do not disclose an address or an address indicative of a type of transaction function device.

Thus, it would not have been obvious to one having ordinary skill in the art to have modified Anderson to produce the recited invention. The Office has not established a *prima facie* showing of obviousness.

Claim 3

Anderson does not teach or suggest an automated transaction machine including a transaction function device having a depository. In an exemplary embodiment of the recited invention, the apparatus has a banking depository (44) for accepting deposits into a secure location in the automated transaction machine.

The cited sections of Anderson refer to a firewall (20) between a router (18) and a web server (22). Appellants request evidence showing that a network firewall is used to accept deposits (i.e., a depository). A firewall operates to keep unwanted electronic messages out. Anderson's firewall has no relation to the recited depository.

Furthermore, the Action has alleged that servers disclosed in Anderson constitute transaction function devices. However, it is unclear how a server (i.e., the alleged transaction function device) can include a depository. Thus, the Office has not established a *prima facie* showing of obviousness.

Claim 4

Anderson does not teach or suggest that a server is operative to deliver a document responsive to the availability of a particular type of transaction function device in the automated transaction machine. Anderson neither teaches nor suggests anything about the availability of a

transaction function, nor the availability of a particular type of transaction function device, nor that a server is operative to deliver a document responsive to such transaction function availability.

Furthermore, because the Action has already alleged the server in Anderson to constitute the recited transaction function device, then it is unclear how this same server can also constitute the recited server in claim 4. It is improper to allege a single component in Anderson as different recited elements of the claim. The Office has not made a *prima facie* showing of obviousness.

Claim 5

Claim 5 depends from claim 4. Anderson does not teach or suggest an automated transaction machine having the recited available transaction function device including a sheet dispenser, and not having an available transaction function device including a depository for carrying out deposit transactions. The Action has already alleged (e.g., in regard to claim 3) that Anderson has a depository. How can Anderson teach or suggest that a document delivered by the server (claim 4) includes no reference to a deposit transaction? Furthermore, what constitutes Anderson's sheet dispenser? The Action is silent as to how Anderson teaches or suggests a sheet dispenser in an automated transaction machine. Thus, the Action is silent as to where Anderson teaches or suggests the recited features and relationships.

Additionally, even if it were somehow possible (which it isn't) for Anderson's firewall to constitute a depository (as alleged with regard to claim 3), then the unavailability of the firewall would not permit Anderson to operate properly. That is, the Action's wrongful interpretation of Anderson would destroy the disclosed and desired utility or operability of the Anderson teaching.

An obviousness rejection cannot be based on a combination of features in a reference if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, Anderson's firewall cannot constitute the recited depository and it would not be obvious to have produced Appellants' recited invention. The Office has not established a *prima facie* showing of obviousness.

Claim 6

Claim 6 depends from claim 4. Anderson does not teach or suggest an automated transaction machine including a sheet dispenser and a depository. Nor does Anderson teach or suggest that a document delivered by the server (claim 4) includes reference to both a dispense transaction and a deposit transaction. The Action is silent as to where Anderson teaches or suggests a sheet dispenser in an automated transaction machine. As previously discussed, Anderson also does not teach or suggest a depository for carrying out deposit transactions. It follows that Anderson does not teach or suggest the recited features and relationships. Hence, the Office has not established a *prima facie* showing of obviousness.

Claim 10

The Action admits that Anderson fails to teach or suggest at least one available transaction function device, where each respective available transaction function device is selectively operative to carry out a respective different type of transaction function.

As previously discussed, Anderson's distributed system cannot constitute an automated transaction machine. Nor can a server in Anderson constitute a transaction function device. Note Appellants' remarks in support of the patentability of claim 1. Anderson also does not teach

or suggest providing first and second HTML documents and accessing either the first or the second document in the manner recited.

The Action is silent as to Anderson teaching plural HTML documents including a respective reference. Appellants respectfully submit that Anderson does not teach or suggest a first HTML document having a first reference to a first transaction type carried out by a first transaction function device. Nor does Anderson teach or suggest a second document having a second reference to a second transaction type carried out by a second transaction function device. It follows that Anderson cannot access either the first or the second document based on types of transaction function devices available in the machine.

There is no teaching or suggestion of an automated transaction machine in Anderson that is capable of having more than one condition or arrangement of available transaction function devices. Anderson provides no teaching or suggestion of a machine having an available first transaction function device but not a second transaction function device. Nor is there a showing in Anderson of a machine having available both the first and the second transaction function devices. Nor does Anderson teach or suggest accessing either a first or second document based on the machine transaction function devices available in the machine. It follows that Anderson does not teach or suggest either accessing a first document (when an automated transaction machine includes a first transaction function device but not a second transaction function device) or accessing a second document (when the machine includes both the first and the second transaction function devices).

Even if it were somehow possible for the distributed system in Anderson to constitute an automated transaction machine and for the clients/servers in Anderson to constitute the recited

transaction function devices (which it isn't), then Anderson would still not teach the capability to determine which HTML document would be accessed based on which transaction function devices an automated transaction machine includes. The claim recites that each of the documents is accessible. Therefore, it would appear (based on the Action's allegation that servers constitute the transaction function devices) that Anderson's machine would have to include a first transaction function device (i.e., first server) and a second transaction function device (i.e., second server) to make the respective first and second documents accessible. However, there is no teaching or suggestion in Anderson that a first document is accessed when the machine includes a first transaction function device but not a second transaction function device, especially when Anderson would require the second server (i.e., the alleged second transaction function device) to make the second document accessible. In a further example, it is unclear how Anderson could make a second document accessible (via a second server), and access the second document when the machine includes both a first server and the second server. That is, there is no teaching or suggestion that Anderson would require both a first server and the second server (i.e., the alleged transaction function devices) to access a second document. It follows that in Anderson there is no relationship to accessing a particular document based on which transaction function devices a machine includes or has available for operation.

Anderson is the sole reference that the action relies upon in presenting the rejection. Appellants acknowledge the Action's admission that Anderson fails to teach or suggest all of the recited features and relationships recited in claim 10. Furthermore, the relied upon sections of Anderson also fail to teach or suggest additional recited features, and relationships, and steps. Thus, the evidence of record does not teach or suggest the recited features, and relationships, and

steps. Appellants respectfully submit that the rejection is not valid due to Anderson's failure to teach or suggest all of the recited features and the lack of any other supporting evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Anderson to have produced Appellants' recited invention. Nor would the alleged modification of Anderson (if somehow even possible) have resulted in the recited features, and relationships, and steps. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 11

As previously discussed, Anderson does not teach or suggest the recited accessing step. It follows that Anderson does not teach or suggest that a first document is accessed at a first address, and a second document is accessed at a second address. The Office has not made a *prima facie* showing of obviousness.

Claim 12

The relied upon sections of Anderson fail to teach or suggest the recited features, and relationships, and steps. Anderson does not teach or suggest delivering device data (representative of the transaction function devices included in the machine) to a server. Nor does Anderson teach or suggest that a document accessed in the accessing step is accessed responsive to the device data. The Action is silent as to Anderson teaching or suggesting device data in the manner recited. The Action is silent as to correlating the accessing of a particular document with device data of transaction function devices as recited in claim 12. Anderson does not teach or

suggest accessing either a first or second HTML document based on data representative of transaction function devices in an automated transaction machine. The Office has not established a *prima facie* showing of obviousness. Nor would the alleged modification of Anderson (if somehow even possible) have resulted in the recited features, and relationships, and steps.

Claim 13

The Action is silent concerning any teaching in Anderson related to the recited features and relationships. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The Action is silent as to where Anderson teaches or suggests a currency dispenser device adapted to selectively dispense currency from an automated transaction machine. Nor does Anderson teach or suggest a currency dispenser device. Nor is Anderson's system capable of dispensing currency. Nor has the Office established a *prima facie* showing of obviousness.

Claim 14

The Action again is silent concerning any prior art teaching of the recited features and relationships. The Action is silent as to where Anderson teaches or suggests an automated transaction machine including a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer device. Nor does Anderson teach or suggest the recited features and relationships. Nor is Anderson's system capable of including the recited features and relationships. Nor has the Office established a *prima facie* showing of obviousness.

Claim 17

The Action relies on Anderson as purportedly teaching the recited features and relationships. However, as previously discussed, Anderson does not teach or suggest a currency dispenser device or a depository device. Thus, the Office has not established a *prima facie* showing of obviousness.

Claim 18

The Action is silent concerning the recited features and relationships. The Action is silent as to where Anderson teaches or suggests first and second transaction function devices from among a card reader device, a currency dispenser device, a depository device, and a receipt printer device. Nor does Anderson teach or suggest the recited features and relationships. Nor is Anderson's system capable of including the recited features and relationships. Nor has the Office established a *prima facie* showing of obviousness.

Claim 19

Claim 19 is an independent method claim. Appellants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein.

The Action is silent concerning the recited steps, features, and relationships. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The Action is silent concerning the recited method steps and relationships. Anderson does not teach or suggest the recited features and relationships. Anderson is devoid of any teaching, suggestion, or motivation to combine features so as to produce the claimed invention. As previously discussed, Anderson does not teach or suggest an availability condition of

transaction function devices in an automated transaction machine. Nor is Anderson concerned with first and second availability conditions of the transaction function devices. It follows that there is no teaching or suggestion in Anderson of an automated transaction machine that has more than one availability condition.

The Action is also silent as to Anderson teaching plural documents including a respective display reference. Nor is there any suggestion in Anderson directed to documents including a display reference corresponding to an availability condition of transaction function devices. Nor is there any suggestion in Anderson of accessing with a browser, either a first or a second document when an automated transaction machine has a first or a second availability condition. Anderson does not show accessing either a first or second document based on an availability condition of an automated transaction machine. Nor does Anderson teach or suggest providing a display corresponding to the document accessed. Where does Anderson teach or suggest providing an output display in the manner recited?

As previously discussed, the Action alleges that Anderson's system is equivalent to the recited automated transaction machine. The Appellants respectfully disagree. As previously discussed (e.g., Appellants' remarks regarding claim 1), Anderson's distributed system cannot perform the recited method.

The Action also apparently relies on Anderson's servers as transaction function devices. The Appellants respectfully disagree. As previously discussed, Anderson does not teach or suggest an automated transaction machine including transaction function devices in the manner recited.

Even if it were somehow possible for the distributed system in Anderson to constitute the recited automated transaction machine, and for the servers in Anderson to constitute the recited transaction function devices (which it isn't), then Anderson would still lack the capability of accessing a document based on an availability condition of transaction function devices.

Appellants further note that the Action admits (page 6, first paragraph; page 7, last paragraph) that Anderson fails to disclose or suggest an "output device." However, the method of claim 19 refers to an output device (second last line). The Action provides no teaching or suggestion (nor relies on any basis or reasoning) to alleviate this admitted deficiency in Anderson. That is, the Action admits that Anderson alone cannot render the claimed invention obvious. However, Anderson is the sole reference that the rejection relies upon. Appellants respectfully submit that in light of the Action's admission that Anderson fails to disclose or suggest all of the recited features, relationships and steps, in view of the absence of any other supporting evidence of record, the rejection is not legally valid. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). The Office has not made a *prima facie* showing of obviousness.

As previously discussed, the Action admits that Anderson does not disclose or suggest all of the recited steps, features, steps and relationships. Therefore, even if it were somehow possible to combine features in Anderson (which it isn't) this would not render the resultant combination obvious because Anderson does not suggest the desirability of the combination (MPEP § 2143.01).

Additionally, the attempts to modify Anderson are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not

constitute a valid basis for a finding of obviousness. *In re Fritch, supra*. Thus, the rejection is improper and should be withdrawn.

Again, if the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01). The Office has not made a *prima facie* showing of obviousness. Therefore, the rejection is improper and should be withdrawn.

Appellants have shown that Anderson does not disclose or suggest the recited features, steps and relationships. Nor does the evidence of record teach or suggest the recited features, steps and relationships. Nor would it have been obvious to one having ordinary skill in the art to have modified Anderson to have produced Appellants' recited invention. Nor would the alleged modification of Anderson (if somehow even possible) have resulted in the recited features, steps and relationships. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 20

Claim 20 depends from claim 19 and further recites that in the method the machine includes a currency dispenser transaction function device.

As previously discussed, the Action is silent as to where Anderson teaches or suggests a currency dispenser transaction function device in an automated transaction machine. Nor does Anderson teach or suggest a currency dispenser transaction function device. Nor is Anderson's system capable of dispensing currency. Nor has the Office made a *prima facie* showing of obviousness.

**The Claims Are Not Obvious Over
Anderson in view of Official notice**

Claims 7-9 and 15-16 were rejected under 35 U.S.C. § 103(a) as obvious over Anderson in view of Official notice. These rejections are respectfully traversed.

Claim 7

The Action alleges that Anderson's network system architecture is equivalent to the recited automated transaction machine. The Action further apparently relies on Anderson's network clients/servers ("servers") as the recited "transaction function devices." The Appellants respectfully disagree. As previously discussed, Anderson's distributed system cannot constitute the recited machine. Nor can servers in Anderson constitute the recited transaction function devices. Note Appellants' remarks in support of the patentability of claim 1.

Even if it were somehow possible for the servers in Anderson to constitute the recited transaction function devices, then what element in Anderson would constitute the recited "server"? The Office cannot rely on the same element in Anderson for different recited elements in Appellants' claim.

Anderson does not teach or suggest the recited features and relationships. The relied upon sections of Anderson fail to teach or suggest the recited features and relationships. Anderson does not teach or suggest an automated transaction machine computer in operative connection with a memory including data representative of a plurality of transaction function devices in the machine. Nor does Anderson teach or suggest the ability to communicate representative data to a server which is operative, responsive to receipt of the data, to deliver an HTML document to a browser, and where the computer is operative responsive to the HTML

document to operate an output device. That is, Anderson does not relate operation of an output device of an automated transaction machine to data representative of a plurality of transaction function devices of the automated transaction machine.

The Action is silent as to where Anderson teaches or suggests memory including "device data" representative of a plurality of transaction function devices in the machine. It is unclear where Anderson has data representative of servers (i.e., the alleged transaction function devices) stored in a memory. The Action is also silent as to how Anderson is able to communicate this memory data to a server to obtain an HTML document for output device operation. Nor does Anderson disclose or suggest the recited features and relationships.

The Action is also silent as to where Anderson teaches or suggests that an automated transaction machine computer is operative responsive to an HTML document to operate an output device. The Action admits that Anderson does not teach or suggest an output device (Action page 6). The Action takes Official notice of a printer as the recited output device.

Appellants respectfully traverse the Official notice assertion on the basis that it is not supported by any reference to prior art. The Patent Office is not permitted to rely merely on assertions of "Official notice" as the basis for rejecting claims, and when challenged is required to establish such assertions in the proper manner through citation to prior art. MPEP § 2144.03.

Appellants already challenged the rationale that a printer output device is well known in the content of the recited invention. Appellants previously requested (e.g., Amendment filed July 14, 2001, at page 20) evidence of an automated transaction machine printer that is able to be operated by a computer responsive to an HTML document delivered to a browser by a server receiving data representative of a plurality of transaction function devices in the machine. That

is, the evidence must show that the operation of the printer is related to the HTML document, and that the printer has the recited relationships. Compliance by the Office with MPEP § 2144.03 was respectfully requested. However, the record still lacks the requested prior art evidence.

The Action's assertions are not based on any evidence in the record. An assertion of knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. The determination of patentability must be based on evidence of record. *In re Lee*, supra. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Nevertheless, even if it were somehow possible for Anderson to have a printer output device (which Anderson doesn't), then there would still be no indication that the printer would be operated responsive to an HTML document. Anderson (modified with a printer) would still not teach or suggest an automated transaction machine output device in the manner recited. It follows that Anderson (modified with a printer) would still not teach or suggest an automated transaction machine as specifically recited.

Appellants respectfully submit that it would not have been obvious to have modified Anderson with the alleged teachings of the Official notice. Appellants further respectfully submit that the Official notice cannot overcome both the admitted and previously discussed deficiencies of Anderson, as nothing discloses or suggests the recited features and relationships which are not found in Anderson. The Office has not made a *prima facie* showing of obviousness. Neither Anderson nor the Official notice, taken alone or in combination, teach or suggest the recited features and relationships. Thus, it would not have been obvious to have

modified Anderson with the Official notice in the manner alleged to have produced the claimed invention.

Claim 8

Anderson does not teach or suggest that a computer in an automated transaction machine is operative responsive to an HTML document, which includes instructions to operate an output device, to operate the output device in the manner recited. Thus, it would not have been obvious to have modified Anderson with the Official notice in the manner alleged to have produced the claimed invention. The Office has not established a *prima facie* showing of obviousness.

Claim 9

Anderson does not teach or suggest server software in operative connection with a server in the manner recited. Anderson does not teach or suggest that server software is operative to generate an HTML document responsive to the receipt of data representative of a plurality of transaction function devices of an automated transaction machine. Anderson does not teach or suggest the ability to communicate data (representative of a plurality of transaction function devices of an automated transaction machine) to a server which is operative to generate (responsive to receipt of the data) and deliver an HTML document to a browser, where a computer is operative responsive to the HTML document to operate an output device. Thus, it would not have been obvious to have modified Anderson with the Official notice in the manner alleged to have produced the claimed invention. The Office has not established a *prima facie* showing of obviousness.

Claim 15

The Action is silent concerning the recited features and relationships. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The Action is silent as to where Anderson teaches or suggests a currency dispenser device adapted to selectively dispense currency from an automated transaction machine. As previously discussed, Anderson does not teach or suggest a currency dispenser device. Nor is Anderson's system capable of dispensing currency. Nor has the Office established a *prima facie* showing of obviousness.

The Action admits that Anderson fails to disclose or suggest an "output device." Appellants respectfully traverse the Official notice assertion on the basis that it is not supported by reference to any prior art. As previously discussed, Appellants have already challenged the Official notice. The Office has not supported the rejection of the features and relationships recited in the claim with citation to relevant prior art as required by MPEP § 2143.03 and 2144.03. The record lacks any prior art teaching or suggestion of having a printer in the apparatus of claim 7 and further in combination with the currency dispenser device of claim 15. In the absence of an express showing of the asserted teachings in the prior art, the rejection is improper and should be withdrawn. The Office has not made a *prima facie* showing of obviousness.

Claim 16

The Action is silent concerning the recited features and relationships. The Action is silent as to where Anderson teaches or suggests an automated transaction machine including a

card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer transaction function device. Nor does Anderson teach or suggest the recited features and relationships. Nor is Anderson's system capable of including the recited features and relationships. Nor has the Office established a *prima facie* showing of obviousness.

Appellants' previous comments regarding the "Official notice" and the alleged output device are incorporated by reference as if fully rewritten herein. Where does the prior art teach or suggest having a printer in an apparatus as recited in claim 7 and further in combination with the features of claim 16? Furthermore, even if it were somehow possible to include Anderson with a printer, then Anderson would still lack the other recited types of transaction function devices. The Office has not established a *prima facie* showing of obviousness.

CONCLUSION

As explained above, each of the claims specifically recites feature, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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APPENDIX

CLAIMS

1. Apparatus comprising:

an automated transaction machine located at a first location, wherein the machine includes:

at least one transaction function device in the machine, wherein the at least one transaction function device includes at least one available transaction function device, wherein each respective available transaction function device is selectively operative to carry out a respective different type of transaction function;

a computer, wherein the computer is in operative connection with each transaction function device;

software executable in the computer, wherein the software includes a browser, wherein the software is operative to enable the computer to access an HTML document which corresponds to the availability of the transaction function devices in the machine.

2. The apparatus according to claim 1 wherein the machine includes different types of transaction function devices, and wherein the computer operates the browser to access the document by generating an address, and wherein at least a portion of the address is indicative of at least one of the types of transaction function devices included in the machine.
3. The apparatus according to claim 1 wherein the machine includes a transaction function device including a depository.
4. The apparatus according to claim 1 and further comprising a server, wherein the server is operative to deliver at least one document to the browser, wherein the document is delivered responsive to the availability of a particular type of transaction function device in the machine.
5. The apparatus according to claim 4 wherein the particular type of transaction function device in the machine includes a sheet dispenser, and wherein the machine does not include an available transaction function device including a depository for carrying out deposit transactions, and wherein the one document delivered by the server includes no reference to a deposit transaction.
6. The apparatus according to claim 4 wherein the available transaction function devices in the machine include a sheet dispenser for carrying out a dispense transaction and a depository for carrying out deposit transactions, and wherein the one document the server is operative to deliver to the browser includes a reference to both a dispense transaction and a deposit transaction.

7. Apparatus comprising:

an automated transaction machine including:

a plurality of types of transaction function devices, wherein each type of transaction function device is selectively operative to carry out a transaction function;

at least one output device, wherein an output device is selectively operative to provide user outputs;

a computer, wherein the computer is in operative connection with a memory, the output device and each of the transaction function devices, and wherein the memory includes device data representative of a plurality of transaction function devices in the machine;

software executable in the computer, wherein the software includes a browser;

a server in operative connection with the computer, and a plurality of HTML documents deliverable through the server;

wherein the computer is operative to communicate data representative of the device data to the server and wherein the server is operative responsive to receipt of the device data to deliver at least one HTML document to the browser for processing wherein the computer is operative responsive to the one HTML document to operate the output device.

8. The apparatus according to claim 7 wherein the one document includes instructions to operate at least one device, and wherein the computer is operative responsive to the one document to operate the device.

9. The apparatus according to claim 7 and further comprising server software in operative connection with the server, wherein the server software is operative to generate the one document responsive to the receipt of the data representative of the device data.

10. A method comprising the steps of:

providing a plurality of HTML documents, wherein each of the documents is accessible through a server, wherein a first document includes a first reference, wherein the first reference is to a first transaction type carried out by a first transaction function device, and wherein a second document is accessible through the server and includes a second reference, wherein the second reference is to a second transaction type carried out by a second transaction function device; and

accessing with a browser operating in a computer in an automated transaction machine, either the first or the second document wherein the first document is accessed when the machine includes the first transaction function device but not the second transaction function device, and wherein the second document is accessed when the machine includes both the first and the second transaction function devices.

11. The method according to claim 10 wherein the accessing step includes accessing the first document at a first address, or accessing the second document at a second address.

12. The method according to claim 10 and prior to the providing step further comprising the step of delivering to the server from the machine device data representative of the transaction function devices included in the machine, wherein the document accessed in the accessing step is accessed responsive to the device data.

13. The apparatus according to claim 1 wherein the at least one available transaction function device in the machine includes a currency dispenser device, wherein the currency dispenser device is adapted to selectively dispense currency from the machine, wherein the computer is in operative connection with the currency dispenser device.

14. The apparatus according to claim 1 wherein the machine includes a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer transaction function device.

15. The apparatus according to claim 7 wherein a transaction function device includes a currency dispenser device in the machine, wherein the currency dispenser device is adapted to selectively dispense currency from the machine, wherein the computer is in operative connection with the currency dispenser device.

16. The apparatus according to claim 7 wherein the machine includes a card reader type of transaction function device, a currency dispenser type of transaction function device, a depository type of transaction function device, and a receipt printer type of transaction function device.

17. The method according to claim 10 wherein the first transaction function device includes a currency dispenser device, and the second transaction function device includes a depository device.

18. The method according to claim 10 wherein the first and second transaction function devices are selected from among a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer transaction function device.

19. A method comprising the steps of:

providing an automated transaction machine including

a computer with a browser, and

a plurality of transaction function devices,

providing a plurality of documents, wherein each of the documents is accessible through a network,

wherein a first document includes a first display reference, wherein the first display reference corresponds to a first availability condition of transaction function devices in an automated transaction machine,

wherein a second document includes a second display reference, wherein the second display reference corresponds to a second availability condition of transaction function devices in an automated transaction machine,

accessing with the browser either the first or the second document,

wherein the first document is accessed when the provided automated transaction machine corresponds to the first availability condition, and

wherein the second document is accessed when the provided automated transaction machine corresponds to the second availability condition,

4)

providing a display to an output device, wherein the display corresponds to the document accessed.

20. The apparatus according to claim 19 wherein the machine includes a currency dispenser transaction function device in the machine.